

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-26 are currently pending in this application. Claims 1, 19, 20, 22, and 24 are independent. The remaining claims depend, directly or indirectly, from claims 1, 20, 22, and 24.

Claim Amendments

Independent claims 1, 19, 20, 22, and 24 have been amended to clarify the present invention as recited. Applicants assert that no new subject matter is added by way of these amendments. Support for these amendments may be found, for example, in paragraphs [0023]-[0025] of the Specification.

Rejections under 35 U.S.C. § 103(a)

Claims 1-4, 6, 7, 12, 14-17, and 20-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,161,098 (“Wallman”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

At the outset, Applicants note that the Examiner does not include claims 5, 8-11, 13, and 18-19 in the recitation of the rejection on page 2 of the Office Action mailed on January 5, 2007. Nevertheless, the Examiner proceeds to include claims 5, 8-11, 13, and 18-19 in the discussion of the rejection with respect to Wallman (*see* Office Action mailed January 5, 2007, page 5-6). Thus,

Applicants deduce that the Examiner is using Wallman to reject claims 5, 8-11, 13, and 18-19 under the same 35 U.S.C. § 103 rejection used to reject the remaining claims of the present application and has proceeded to traverse the rejection accordingly.

Turning to the rejection of the claims, to establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (*See* MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (*See* MPEP §2143.03). The Applicant respectfully asserts that Wallman fails to teach or suggest all the claim limitations of the amended independent claims.

The amended independent claims recite, in part, “wherein the potential *total* future tax liability of the user is computed using tax return information *of the user* stored in a tax profile.” The claimed invention also clearly recites that a *total* tax liability is computed for the user using tax information obtained from “tax return data for at least one tax year of the user.”

In contrast to the claimed invention, Wallman teaches computing a tax liability for *a particular transaction or series of transactions* (*i.e.*, selling of stocks/bonds/assets/liabilities) (*see* Wallman, col. 3, ll. 35-37). Wallman clearly states “determining the potential tax consequences that would result from trading various combinations of the plurality of assets/liabilities, in which each of the potential tax consequences represents the potential tax consequence that would result from trading one particular subset of assets/liabilities.” Clearly, Wallman is focused only on tax consequences resulting from a particular sale of one or more securities, and does not use any *tax information of the user* to compute such tax consequences to the user’s potential *total* future tax

situation (as a whole). Rather, Wallman only uses information related to the sale of assets/liabilities to compute tax consequences associated with *that sale*. Said another way, Wallman is focused on using information from a *securities transaction* to compute tax liability as it relates solely to that transaction, and not tax information associated with a *user's overall tax scenario*.

In fact, Wallman completely silent and therefore cannot teach or suggest obtaining tax information from a *user's tax return* from at least one tax year of the user. The Examiner cites column 6, lines 6-12 of Wallman as disclosing tax return information. The cited portion of Wallman for this limitation of the recited claims merely discloses the use of information stored in tax programs to compare such tax program information to capital assets stored in the database to identify potential tax savings from engaging in *a transaction* involving the capital assets. Again, Wallman completely fails to teach or suggest that tax return information is obtained from the tax programs. More importantly, Wallman also fails to teach or suggest using the information stored in the tax programs to compute a user's potential *total* future tax liability, as required by the amended independent claims. At most, Wallman arguably teaches that the tax program information is used to compute the tax consequences associated solely with *the transaction(s)* involving the capital assets without taking into account the overall tax liability of the user (*i.e.*, whether the taxpayer gets a refund or is required to pay additional taxes when filing the future tax return).

Thus, it is clear that because Wallman does not consider overall tax information of a user in computing tax liability of a user, it is not possible for Wallman to provide a user with a *total* future tax liability. At best, Wallman provides a user with the tax consequences directly related to one or more securities transaction in which the user engages.

In view of the above, it is clear that Wallman fails to render the amended independent claims obvious. Thus, Wallman fails to support the rejection of amended independent claims 1, 19, 20, 22, and 24. Dependent claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 37202/102001).

Dated: April 5, 2007

Respectfully submitted,

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